

## **REMARKS/ARGUMENTS**

Claims 1-30 are pending in the present application.

This response is to respond the Final Office Action mailed August 8, 2008 to support a Request for Continued Examination (RCE) filed concurrently. In the Final Office Action, the Examiner rejected claims 1-30 under 35 U.S.C. §103(a). Applicant has amended claims 1, 3, 4, 8, 11, 13, 14, 18, 21, 23, 24, and 28. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

### ***Blount is not a proper prior art***

In the Final Office Action, the Examiner continues citing U.S. Publication No. 2006/0148527A1 issued to Blount ("Blount"). As discussed in the previous response, Applicant submits that Blount is not a proper prior art. The earliest priority date of Blount established by the provisional application is December 18, 2002, which is predicated by the filing date of the current application.

Applicant respectfully requests the Examiner to withdraw Blount as a prior art in rejecting claims 4, 10, 14, 20, 24, and 30.

### ***Rejection Under 35 U.S.C. § 103***

In the Final Office Action, the Examiner rejected claims 1-3, 5-9, 11-13, 15-19, 21-23, and 25-29 under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2002/0136462 A1 issued to Herber ("Herbert") in view of U.S. Patent No. 6,370,581 B2 issued to Rader ("Rader") and further in view of U.S. Publication No. 2001/0053978 A1 issued to Lewis ("Lewis"); and claims 4, 10, 14, 20, 24, and 30 under 35 U.S.C. §103(a) as being unpatentable over Herbert in view of Rader and further in view of Lewis and further in view of U.S. Publication No. 2006/0148527A1 issued to Blount ("Blount"). Applicant respectfully traverses the rejection and submits that the Examiner has not met the burden of establishing a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP §2143, p. 2100-126 to 2100-130 (8th Ed., Rev. 5, August 2006)*. Applicant respectfully submits that there is no suggestion or motivation to combine their teachings, and thus no *prima facie* case of obviousness has been established.

Furthermore, the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated: “Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.” MPEP 2141. In *KSR International Co. vs. Teleflex, Inc.*, 127 S.Ct. 1727 (2007) (Kennedy, J.), the Court explained that “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” The Court further required that an explicit analysis for this reason must be made. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR* 127 S.Ct. at 1741, quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). In the instant case, Applicant respectfully submits that there are significant differences between the cited references and the claimed invention and there is no apparent reason to combine the known elements in the manner as claimed, and thus no *prima facie* case of obviousness has been established.

1. Claims 1-3, 5-9, 11-13, 15-19, 21-23, and 25-29:

Herbert discloses a system, device, computer program product, and method for representing a plurality of electronic ink data points. A pen-enabled computing device includes a writing stylus, a handwriting capture interface and a processing element. The handwriting capture interface may include an electronic handwriting tablet that is capable of sensing the position of the writing stylus. The processing element is capable of determining a high-order derivative of the electronic ink data points and thereafter encoding the high-order derivative of

the plurality of electronic ink data points, such as by Huffman encoding. (Herbert, paragraph [0007], lines 7-18).

Rader discloses a method, apparatus, and product for transmitting multibyte characters in a network. UTF-8 is an example of a variable-width or "multibyte" encoding format developed to support multilingual text (Rader, col. 2, lines 18-20). To create an HTTP request in UTF-8 format, web browser 220 will convert the data string from its current format to UTF-8 and transmit the UTF-8 data string and an HTTP request header across the network. An HTTP request header typically contains information that server 130 requires to accurately parse the accompanying data string into bytes to understand the HTTP request (Rader, col. 6, lines 26-32).

Lewis discloses a system and method for providing user-directed constraints for handwriting recognition. A user selects between a "default recognition" mode and a "constrained recognition" mode via a user interface. In the default recognition mode, a recognition engine utilizes predetermined default recognition parameters to decode data (e.g., handwriting and speech). In the constrained recognition mode, the user can select one or more of a plurality of recognition constraints which temporarily modify the default recognition parameters to decode uncharacteristic and/or special data. (Lewis, Abstract)

Herbert, Rader, and Lewis, taken alone or in any combination, do not disclose or render obvious, at least one of: (1) an encoder to encode data in a first format from an input device into a string of data having a second format supported by a server having an infrastructure, the first and second formats being different; (2) a packetizer coupled to the encoder to break the string of data into packets no larger than maximum message size allowed by the infrastructure, the packets having at least one packet having a header, the header identifying the first format; and (3) a management layer coupled to the packetizer to process the packetized string of data using a processing function, the processing function being enabled or disabled using a configuration user interface, as recited in claims 8, 18, and 28; or (4) a decoder to decode a received packet encoded in the second format back into the data having the first format, as recited in claims 1, 11, and 21.

Herbert merely discloses a handwriting capture interface to capture the (x,y) coordinates of the point of the stylus and a processing element to determine a high order derivative for each successive point and encode each high-order derivative (Herbert, paragraph [0029], lines 2-5; paragraph [0032], lines 3-7; paragraph [0036], lines 1-4), not an encoder to encode data in a first

format from an input device into a string of data having a second format. Herbert discloses encoding the high-order derivatives for the successive points. From the raw (x,y) coordinates, the second derivatives for the successive points are determined (Herbert, paragraph [0033], Table 1). Then, the encoding is performed on the second derivatives. The encoding, therefore, is not performed on the data from an input device, but on the second derivatives. This second derivative format is not supported by a server having an infrastructure. To clarify this aspect of the invention, claims 1, 8, 11, 18, 21, and 28 have been amended.

In addition, Rader merely discloses an HTTP request header typically contains information that server 130 requires to accurately parse the accompanying data string into bytes to understand the HTTP request (Rader, col. 6, lines 26-32), not a packetizer to break the string of data into packets no larger than maximum message size allowed by the infrastructure, the packets having at least one packet having a header, the header identifying the first format. Rader merely discloses the web browser converts the data string from its current format to UTF-8. Converting does not break the string into packets no larger than maximum message size allowed by the infrastructure. Furthermore, the HTTP request header merely allows the server to parse the data string, not to identify the first format.

Moreover, Lewis merely discloses a user to select between a default recognition and a constrained recognition, not a processing function being enabled or disabled using a configuration user interface. A user is not a processing function. Selecting between the two types of recognition is not the same as enabling or disabling the processing function. Selecting allows the user to choose one of the recognition types. It does not allow the user to enable or disable a processing function.

2. Claims 4, 10, 14, 20, 24, and 30:

Herbert, Rader, and Lewis are discussed above.

Blount discloses mobile graphics device and server. A facility exchanges hand drawn graphics images between graphics devices and a corresponding graphics device (Blount, paragraph [0030], lines 1-4). A list of pre-defined group may be established using an instant messaging system. The arrangement of data indicating the presence of a user for responding to an availability for exchanging hand drawn graphics may be provided in accordance with an instant messaging server (Blount, paragraph [0030], lines 7-9; lines 15-20).

As discussed above, Herbert, Rader, and Lewis, taken alone or in any combination, do not disclose or render obvious elements (1) – (3), or (1), (2), and (4) as above. Accordingly, a combination of Herbert, Rader, and Lewis with any other references in rejecting claims 4, 10, 14, 20, 24, and 30 is improper.

Furthermore, Applicant submits that Blount is not a proper prior art. The earliest priority date of Blount established by the provisional application is December 18, 2002, which is predicated by the filing date of the current application.

The Examiner failed to establish a *prima facie* case of obviousness and failed to show there is teaching, suggestion, or motivation to combine the references. When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Col, Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). “When determining the patentability of a claimed invention which combined two known elements, ‘the question is whether there is something in the prior art as a whole suggest the desirability, and thus the obviousness, of making the combination.’” *In re Beattie*, 974 F.2d 1309, 1312 (Fed. Cir. 1992), 24 USPQ2d 1040; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ (BNA) 481, 488 (Fed. Cir. 1984). To defeat patentability based on obviousness, the suggestion to make the new product having the claimed characteristics must come from the prior art, not from the hindsight knowledge of the invention. *Interconnect Planning Corp. v. Feil*, 744 F.2d 1132, 1143, 227 USPQ (BNA) 543, 551 (Fed. Cir. 1985). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the prior elements from the cited prior references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1996), 47 USPQ 2d (BNA) 1453. “To support the conclusion that the claimed invention is directed to

obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973. (Bd.Pat.App.&Inter. 1985). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Furthermore, although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682, 16 USPQ2d at 1432; *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992), 23 USPQ2d 1780.

Moreover, the Examiner failed to establish the factual inquires in the three-pronged test as required by the *Graham* factual inquires. There are significant differences between the cited references and the claimed invention as discussed above. Furthermore, the Examiner has not made an explicit analysis on the apparent reason to combine the known elements in the fashion in the claimed invention. Accordingly, there is no apparent reason to combine the teachings of Herbert, Rader, and Lewis in any combination.

The Examiner failed to establish a *prima facie* case of obviousness and failed to show there is teaching, suggestion, or motivation to combine the references. When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Col, Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). "When determining the patentability of a claimed invention which combined two known elements, 'the question is whether there is something in the prior art as a whole suggest the desirability, and thus the obviousness, of making the combination.'" *In re Beattie*, 974 F.2d 1309, 1312 (Fed. Cir. 1992), 24 USPQ2d 1040; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ (BNA) 481, 488 (Fed. Cir. 1984). To defeat patentability based on obviousness, the suggestion to make the new product having the

claimed characteristics must come from the prior art, not from the hindsight knowledge of the invention. *Interconnect Planning Corp. v. Feil*, 744 F.2d 1132, 1143, 227 USPQ (BNA) 543, 551 (Fed. Cir. 1985). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the prior elements from the cited prior references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1996), 47 USPQ 2d (BNA) 1453. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973. (Bd.Pat.App.&Inter. 1985). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Furthermore, although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682, 16 USPQ2d at 1432; *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992), 23 USPQ2d 1780.

Moreover, the Examiner failed to establish the factual inquires in the three-pronged test as required by the *Graham* factual inquires. There are significant differences between the cited references and the claimed invention as discussed above. Furthermore, the Examiner has not made an explicit analysis on the apparent reason to combine the known elements in the fashion in the claimed invention. Accordingly, there is no apparent reason to combine the teachings of Herbert, Rader, Lewis and Blount.

In the present invention, the cited references do not expressly or implicitly disclose any of the above elements. In addition, the Examiner failed to present a convincing line of reasoning as to why a combination of Herbert, Rader, Lewis and Blount is an obvious application of transmitting new data format under existing infrastructure or an explicit analysis on the apparent reason to combine Herbert, Rader, Lewis in the manner as claimed.

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Therefore, Applicants believe that independent claims 1, 8, 11, 18, 21, 28 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicants respectfully request the rejection under 35 U.S.C. §103(a) be withdrawn.

***Conclusion***

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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